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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,461	12/12/2003	Bonnie M. Pemberton	31960.0104	9697

7590 03/06/2006

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EXAMINER

OSELE, MARK A

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/734,461

Applicant(s)

PEMBERTON ET AL.

Examiner

Mark A. Osele

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-15, 42-45 and 47 is/are pending in the application.
- 4a) Of the above claim(s) 7-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 42-45 and 47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Request for Information</u> . |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-4, 42-45, and 47, drawn to a double sided adhesive tape on a base sheet, classified in class 428, subclass 42.2.
 - II. Claims 7-15, drawn to a corrugated base sheet with a single sided adhesive tape, classified in class 428, subclass 40.1.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are directed to related products. The related inventions are distinct if the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 806.05(j). In the instant case, the two inventions are distinct. Invention I includes limitations to a plurality of double sided adhesive tapes on a transfer sheet and invention II includes limitations to a rigid, corrugated plastic strip with adhesive on one surface adhered to a release layer.
3. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

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4. During a telephone conversation with George Schultz on February 22, 2006 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-4, 42-45, and 47. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-15 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The following claim amendment is new matter not described in the original disclosure: Claim 4, lines 1-2, "wherein the strips are fairly rigid, rectangular

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and corrugated plastic.” The rigid, corrugated plastic strips are only disclosed as being coated with adhesive on one side, not two sides as required by independent claim 1.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 includes the limitation “of sufficient strength to cause an unpleasant sticking sensation to pets” which is indefinite because there is no definition in the originally filed disclosure what strength would be of sufficient strength to create an unpleasant sticking sensation. In addition, it is presumed that different species of pets and different animals within a species would have different thresholds for what strength of adhesive would create an unpleasant sticking sensation. For this reason one of ordinary skill in the art would be unable to determine what adhesive force would be infringing and what force would not be infringing on the claims as currently drafted.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Italian Patent 590,156 (Avery Adhesive) in view of Kriozere. Avery Adhesive shows the construction of double sided adhesive tapes, 11, on a continuous backing release layer, 20, with individual release sheets, 10, overlying the individual tapes (See Figs. 1, 3). It is noted that double sided adhesive tapes are typically transparent, therefore, it would have been obvious to make both the base web and the two adhesive layers transparent. Furthermore, absent evidence to the contrary, it is presumed that the adhesive tapes of Avery Adhesive are of sufficient strength to create an unpleasant sticking sensation to pets. Avery Adhesive fails to show the claimed water soluble adhesive.

Kriozere shows a rectangular adhesive strip, 12, with a release layer, 16, 18, bisected along an axis, 20, parallel to the length of the strip covering the adhesive layer, 14 (column 1, line 65 to column 2, line 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the bisect the release layer of the references as combined because Kriozere shows that after removing one of the release layers, the edge of the remaining release layer can be used to align the adhesive strip on an article (Figs. 1-3).

12. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Italian Patent 590,156 (Avery Adhesive) in view of Kriozere as applied to claim 1 above, and further in view of Sato. The references as combined fail to disclose gaps between the individual double sided adhesive tapes.

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Sato teaches that cutting labels on a backing sheet to create gaps between the individual labels allows for easier separation from the backing sheet than the prior art (column 5, lines 20-24; column 5, lines 68 to column 6, line 7). Sato also shows that this gap is wide enough to distinguish the side of the labels from a bisecting perforation in the release sheet (See Figs. 6, 10). It would have been obvious to one of ordinary skill in the art at the time the invention was made to space the individual double sided adhesive tapes of the references as combined in the manner of Sato because Sato teaches the spacing to aid in label release. In addition, it would have been obvious to one of ordinary skill in the art that spaced individual adhesive tapes could be more easily removed by hand.

13. Claims 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekula in view of Geary. Sekula shows double sided adhesive tape releasably adhered to a corrugated substrate, 26, on the first adhesive surface, 22, and having a release layer, 28, adhered on the second adhesive surface, 24 (column 2, lines 25-34). Sekula fails to show the corrugated substrate to be substantially flat.

Geary teaches that double sided adhesive tapes can be supplied on a substrate that is either in a roll, in stacks, or any other packaging. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the double sided adhesive tape of Sekula on a flat sheet because Geary teaches double sided adhesive tapes can be provided on substrates that are either flat or in rolls.

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Regarding claim 43, Sekula teaches that the substrate can be plastic (column 3, lines 23-29.)

Regarding claim 44, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a colored substrate because colored and printed substrates are commonly used for identification and advertising purposes.

14. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sekula in view of Geary as applied to claim 42 above and further in view of Anhauser et al. The references as combined show double sided adhesive tape releasably adhered to a flat corrugated substrate but fails to show the release layer including a cut that divides the release layer into two sections.

Anhauser et al. teaches that it is known to provide linear cuts in the backing layer protecting adhesive to aid in removal of the backing material into two pieces (column 1, lines 54-60). Anhauser et al. further shows an elongate adhesive label with a lengthwise slit in the protective layer (Fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a lengthwise slit in the cover layer of the references as combined because Anhauser et al. teaches the value in such a slit for separating and peeling a cover sheet from an adhesive layer.

15. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sekula in view of Geary and Anhauser et al. as applied to claim 45 above, and further in view of

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Sato. The references as combined fail to disclose gaps between the individual double sided adhesive tapes.

Sato teaches that cutting labels on a backing sheet to create gaps between the individual labels allows for easier separation from the backing sheet than the prior art (column 5, lines 20-24; column 5, lines 68 to column 6, line 7). Sato also shows that this gap is wide enough to distinguish the side of the labels from a bisecting perforation in the release sheet (See Figs. 6, 10). It would have been obvious to one of ordinary skill in the art at the time the invention was made to space the individual double sided adhesive tapes of the references as combined in the manner of Sato because Sato teaches the spacing to aid in label release. In addition, it would have been obvious to one of ordinary skill in the art that spaced individual adhesive tapes could be more easily removed by hand.

Response to Arguments

16. Applicant's arguments with respect to claims 1-4, 42-45, and 47 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ittershagen et al. teaches a double sided adhesive sheet with one surface having adhesive strong enough to provide an unpleasant sticking sensation

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to the paws of a cat. Byrne shows an article for placement on furniture to prevent a pet from stepping on the article.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Osele whose telephone number is 571-272-1235. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MARK A. OSELE
PRIMARY EXAMINER

February 28, 2006



Request for Information

1. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.
2. In response to this requirement, please provide a copy of each of the following items of art referred to in the Petition to Make Special filed on November 15, 2004: The device and method on the market referred to in the petition which infringes the claims of the instant application, including the manufacturer, model, and any other identifying information known to applicant, and when the device and method first went into public use, as well as copies of any literature describing the device and method known to applicant, including instructions or product brochures.
3. The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement

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under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

4. This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.


GREGORY MILLS
QUALITY ASSURANCE SPECIALIST

MARK A. OSELE
PRIMARY EXAMINER
February 28, 2006